

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Paul G. Glucina et al.

Serial No.: 09/905,574

Title of Invention: PEACH TREE NAMED 'GL4/66'

Filing Date: July 12, 2001

Examiner: S. McCormick-Ewoldt, Art Unit 1661

Docket No.: HR1.P03

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 17, 2005
Yakima, Washington 98902

TRANSMITTAL OF BOARD DECISION IN RELATED PROCEEDING

Sir:

The Appeal Brief in the above referenced application was submitted on September 24, 2004. Since that time, the Board of Patent and Appeals and Interferences has rendered a decision in one of the cases referenced in Paragraph 2, Related Appeals and Interferences. In application Ser. No. 09/590,861, the Board has remanded the application to the examiner, with the comment that "the issues raised in the present rejection are based upon a new interpretation or application of the existing patent law and the rejection should be reviewed according to the procedure set forth in this section [Section 1208, Rev. 2, May 2004] of the MPEP." Appeal No. 2004-1830, Remand to the Examiner, April 28, 2004, p. 3

Applicant believes the Board's opinion in this related case is relevant to the present appeal, and therefore submits herewith a complete copy of the opinion for consideration in this case.

Respectfully Submitted,



Michelle Bos, PTO Reg. No. 45,499
STRATTON BALLEW PLLC
243 South 12th Avenue
Yakima, WA 98902
Telephone (509) 453-1319
Facsimile (509) 453-4704

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The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**Ex parte EVERETTE W. BRANDTAppeal No. 2004-1830
Application No. 09/590,861**MAILED**

APR 28 2005

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

HEARD: March 8, 2005

Before WILLIAM F. SMITH, SCHEINER, and ADAMS, Administrative Patent Judges.
WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Having heard oral argument on March 8, 2005, and taking the appeal under advisement, we have determined that this case is not in condition for a decision on appeal. Accordingly, we remand the case to the examiner to consider the issues raised below and take appropriate action.

Background

This plant patent application describes a nectarine tree denominated "DN-02." According to appellant, DN-02 is "distinguishable from other nectarine varieties by the unique flattened shape of its fruit." Specification, page 1.

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Figures 1-5 of the application are stated to respectively show a representative fruit, the flesh of a representative fruit, the stone of a representative fruit, a representative branch and a representative limb of DN-02. Id. DN-02 is stated to be a "limb sport mutation from a peento-type peach tree of unknown origin, and was found in a cultivated orchard near Parker, Washington" Id.

Appellant provides a botanical description of DN-02 on pages 2-5 of the specification which is stated to be based on observations made in Parker, Washington, U.S.A. Id., page 2. Appellant indicates that, since the botanical description resulted from the ecological conditions that existed in the area of Parker, Washington, U.S.A., where DN-02 was grown and tested, it is to be expected that variations of the described characteristics may occur if DN-02 is grown in areas under different climatic conditions, soil types and/or varying cultural practices. Id., pages 5-6.

The present claim stands rejected under 35 U.S.C. § 112, first and second paragraphs. Examiner's Answer, page 4. The examiner lists specific concerns in regard to how the specification describes DN-02 as items A - U on pages 4-7 of the Examiner's Answer.

In response, appellants do not directly respond to any of the specific points A - U set forth in the Examiner's Answer. Rather, the position taken by appellant in the Appeal Brief¹ is that the specification is reasonably complete and meets the requirements of the statute. See, e.g., Appeal Brief, page 3.

¹ Reference to the "Appeal Brief" in this opinion is to the "Supplemental Appeal Brief," Paper No 21.

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Finally, we note the claim in this plant patent application is not rejected on prior art grounds.

Remand

The Manual of Patent Examining Procedure (MPEP) § 1208, (Rev. 2, May 2004),

provides:

If an examiner's answer is believed to contain a new interpretation or application of the existing patent law, the examiner's answer, application file, and an explanatory memorandum should be forwarded to the TC Director for consideration. See MPEP § 1003. If approved by the TC Director, the examiner's answer should be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for final approval.

In our view, the issues raised in the present rejection are based upon a new interpretation or application of the existing patent law and the rejection should be reviewed according to the procedure set forth in this section of the MPEP.

35 U.S.C. § 162 (Rev. 2, May 2004) states in relevant part:

No plant patent shall be declared invalid for non-compliance with section 112 of this title if the description is as complete as is reasonably possible.

37 CFR § 1.163(a) (July 2004) sets forth how a plant should be described in the specification of a plant patent application as follows:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. For a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

Section 162 of the Code only requires that the plant be described in the specification "as complete as is reasonably possible" in order to comply with § 112.

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Rule 163 appears to be more restrictive than the statute in that the rule requires the specification contain "as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents . . ." The tenor of Rule 163(a) is that the description of the plant in the specification must be sufficient so that the claimed plant can be distinguished from other known varieties and the claimed plants antecedents.

Here, the description of DN-02 in the specification appears to have been sufficient for the examiner to compare DN-02 to prior art nectarine trees and determine the DN-02 is free of the prior art since the examiner has not specifically tied any of points A-U to an inability to compare DN-02 to the prior art and has not applied a prior art rejection. Rather, the examiner's concern appears to be directed to future events such as examination of plant patent applications directed to other nectarine trees and being able to distinguish those future trees from DN-02. For example, the examiner states "[a]s the list of issued plant patent grows, complete and concise descriptions are needed to aid in examining future plant patent applications." Examiner's Answer, page 9.

This aspect of the examiner's position appears to be a new interpretation of the patent laws in that the examiner has not cited any authority in support of the proposition that the description of a plant in a plant patent application must be sufficiently complete and concise so that the description is an aid in examining future plant patent applications as opposed to describing the new plant in such a manner that the patentability of the plant under review can be determined.

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Another aspect of the examiner's position that should be reviewed upon return of the application is the potential that this new standard of description for a plant patent may become arbitrary. While in no way suggesting the examiner in this application was arbitrary, we note the final rejection of this application (Paper No. 15) lists points A - K as reasons in support of the rejection. Final Rejection, pages 2-3. Upon filing a first Appeal Brief (Paper No. 17, January 13, 2003), the examiner reopened prosecution and expanded the reasons why the specification of this plant patent application was purportedly deficient. As seen from the Examiner's Answer, the examiner now relies upon points A - U. It may be that focusing on the description of a plant in a plant patent application for the purpose of completeness to compare the claimed plant to possible future plants can become a never ending process with an applicant meeting an examiner's request for more descriptors only to be met with a new list of concerns.

The examiner has made of record four plant patents directed to nectarine trees.² A review of these four plant patents reveals that the individual nectarine trees are described in a variety of ways and there is no one set way in which a nectarine tree must be described in order for an examiner to determine whether it distinguishes from prior art trees and the claimed trees antecedents. At oral argument, counsel indicated there is an international standard for describing plants. However, the briefing in this case makes no reference to such a standard so we are not in a position to review or comment upon such a standard.

²

Marshall	8,570	Feb. 1, 1994
Escande	9,107	Apr. 18, 1995
Bradford et al. (Bradford '695)	11,695	Dec. 12, 2000
Bradford et al. (Bradford '711)	11,711	Dec. 19, 2000

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A review of the case law is not helpful in this situation. The one case we are aware of directed to sufficiency of disclosure of plant patent applications, In re Greer, 484 F.2d 488, 179 USPQ 301 (CCPA 1973), was focused on whether the specification of that plant patent application provided a sufficient description of the claimed Bermuda grass plant such that a meaningful comparison with prior art plants could be made. In that case, the PTO submitted the application to the Department of Agriculture for evaluation of the assertions made that the claimed Bermuda grass was a distinct and new variety of plant. As reported in Greer, the Department of Agriculture's report stated that "[t]he description of the claimed grass is not adequate to determine if it differs from other named bermudagrasses." Id. at 490, 179 USPQ at 303. The court stated in considering the disclosure requirements of 35 U.S.C. § 162:

Nevertheless, we do not agree that it was contemplated by Congress that its incorporation into R.S. 4888 of the matter which is the statutory predecessor to § 162 would operate to allow an applicant to allege characteristics which might be capable of distinguishing one variety of plant from another without sufficient disclosure to establish that these characteristics are indeed present in the claimed plant and absent in the varieties to which it is most closely related. In fact, the portion of the legislative history relied upon by the board makes it clear that the applicant bears the burden of clearly and precisely describing those characteristics which define the new variety.

Id. at 491, 179 USPQ at 303. The court then concluded that "it is incumbent upon the applicant to provide information of such a character that a meaningful comparison can be made." Id. The comparison referenced was with prior art plants, not plants that may be claimed in future plant patent applications.

Another point that should be considered upon return of this application is whether the examiner's concerns in regard to the description of DN-02 in the

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specification are better addressed by way of an objection to the specification which would be reviewable by petition under 37 CFR § 1.181 instead of a rejection of the claim and an appeal as has occurred. Since the description of DN-02 supplied by appellant to date is adequate for the examiner to examine the merits of the claimed nectarine tree and determine that it is free of the prior art, we do not have the situation that occurred in In re Greer. Rather, the examiner's concerns regarding future events and whether the description of DN-02 is adequate to distinguish DN-02 from future nectarine trees appear to be more of a policy question rather than a merits question that would be more readily addressed by way of an objection to the specification which a dissatisfied applicant may have reviewed by way of petition. See In re Hengehold, 440 F.2d 1395, 1404, 169 USPQ 473, 479 (CCPA 1971) (Not every adverse decision by an examiner is "perforce reviewable by the [Board]....There are a host of various kind of decisions an examiner makes in the examination proceeding--mostly matters of a discretionary, procedural or nonsubstantive nature--which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejection of claims, but traditionally have been settled by petition to the [Director].").

Finally, another reason why the examiner's position should be reviewed in accordance with the procedure set forth above in MPEP 1208 is appellant's statement at page 2 of the Appeal Brief that "the issue in this case...is relevant to many pending plant patent applications that have been rejected on the same grounds as the present

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case." Such wide ranging issues of first impression should be reviewed as indicated in

MPEP 1208.

REMANDED

William F. Smith
William F. Smith
Administrative Patent Judge

Toni R. Scheiner
Toni R. Scheiner
Administrative Patent Judge

Donald E. Adams
Donald E. Adams
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

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Stratton Ballew
213 S. 12th Avenue
Yakima, WA 98902

dem



ATTORNEYS AND COUNSELORS AT LAW

213 South 12th Ave • P.O. Box 428
YAKIMA, WASHINGTON 98907
Telephone (509) 453-1319
Facsimile (509) 453-4704

P.O. Box 636
VASHON, WASHINGTON 98070-0636
Telephone (206) 682-1496
Facsimile (206) 260-3816

PATRICK H. BALLEW, P.S.
REX B. STRATTON, P.S.
CHRIS E. SVENDESEN
QUINTEN S. BOWMAN

MICHELLE D. BOS, R.S. Chem., Biol.
Patent Agent

GEORGE A. CASHMAN

1922-1997

REPLY TO YAKIMA

FACSIMILE TRANSMISSION COVER SHEET

Date: December 1, 2005

Our File No. **HR1.P03**Number of Pages: 12 (not including this page)To: **Dianne Maggard**Company Name: **Board of Patent Appeals and Interferences
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Attn: Dianne Maggard
Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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1. Supplemental Related Proceedings Appendix

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Michelle Bos